REMARKS/ARGUMENTS

This Amendment is responsive to the Final Office Action mailed March 2, 2010 ("FOA"). Prior to this Amendment, claims 1, 3, 28-34, 36, and 37 were pending. By way of this Amendment, claim 1 is amended, claims 14, 17-25, and 35 are canceled, and claims 38-42 are added. No new matter has been added. After entry of this Amendment, claims 1, 3, 28-34, and 36-42 are pending and subject to examination on the merits.

I. Election/Restriction:

In response to the Applicants' election with traverse of Group I for further prosecution, filed on October 15, 2009, the Examiner alleges that the traversal is not found persuasive because, "further search and/or consideration may be required." (FOA, page 2). Although Applicants do not agree with the Examiner's allegation, in the interests of advancing prosecution, claims 14, 17-25 and 35 of unelected Group II are canceled.. Applicants reserve the right to pursue the non-elected claims of Group II in one or more divisional applications.

II. Claim Rejection under 35 U.S.C. § 101:

Claims 1, 3, 28-33, 36 and 37 are rejected under 35 U.S.C. § 101, because the claims are allegedly not tied to another statutory class. This rejection is traversed. Although Applicants do not agree with the Examiner's allegation, in the interests of advancing prosecution, claim 1 has been amended to clarify a tie to a particular machine. Withdrawal of this rejection of claim 1, and the claims which depend therefrom is respectfully requested.

III. Claim Rejections Under 35 U.S.C. § 103:

A. Hoffman (U.S. 7,249,080), Perkel (U.S. 2002/0062273), Zeitoun (2005/0027632), and Bove (U.S. 7,149,713)

Claims 1, 3, 29-32, 34, 36, and 37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Hoffman* (U.S. 7,249,080) in view of *Perkel* (U.S. 2002/0062273), further in view of *Zeitoun* (U.S. 2005/0027632), and further in view of *Bove* (U.S. 7,149,713). This rejection is traversed. Obviousness has not been established because (1) even in combination, each and every limitation of the claims is not taught or suggested and (2) the references were combined using improper hindsight.

1. *Obviousness has not been established since each and every limitation of the claims is not taught or suggested by the cited art.*

Obviousness has not been established with respect to independent claim 1 and claims dependent thereon, because all limitations are not taught or suggested by the cited art, alone or in combination. For example, at least the following limitation is not taught or suggested by the cited references: "*recommending placing assets into the included accounts in a tax efficient manner.*" Neither *Hoffman*, *Perkel*, *Zeitoun*, nor *Bove*, alone or in combination, teach or suggest the feature of "*recommending placing assets into the included accounts in a tax efficient manner.*"

The Examiner relies on the abstract and column 4, lines 48-67 of *Bove* in alleging that *Bove* teaches the feature of "*recommending placing assets into the included accounts in a tax efficient manner.*" (FOA, Page 8). Applicants again submit that *Bove* fails to teach or suggest this feature. *Bove* describes the use of data to "automatically generate financial transaction recommendations for modifying the client's current asset portfolio recommendations." (*Bove*, Abstract). The recommendations in *Bove* are "selected in a manner which minimizes the tax impacts and transaction costs of potential sell transactions." (*Id.*) *Bove*, however, does not disclose the feature of "*recommending placing assets into the included accounts in a tax efficient manner.*" As previously argued, the cited portion of *Bove* merely

describes that tax advantaged accounts exist, and that it is possible to buy stocks in tax advantaged accounts.

The Examiner additionally relies on column 4, lines 48-67 of *Bove*. At page 12 of the FOA, the Examiner states:

> 46. Bove, at abstract and column 4, lines 48-67, teaches first- placing stocks into a Roth IRA if available, second – purchasing stocks into an annuity if available, ..., fourth placing stocks into taxable accounts, etc.. Therefore, Bove teaches recommending placing assets into multiple accounts in a tax efficient manner

Bove does not describe a "*tax efficient manner*" to recommend "placing assets into the included accounts." There is no reasoning provided in *Bove* regarding the selection of a particular tax advantaged account. To expedite prosecution, claim 1 has been amended to recite, *inter alia*, "*recommending placing assets into the included accounts in a tax efficient manner, wherein the tax efficient manner comprises selecting the assets with least tax efficiency for purchase in the included accounts that are most tax advantaged.*" This tax efficient manner is not taught or suggested by *Bove*, as *Bove* simply recites an ordered list of accounts without describing the relative tax efficiency of each account. The other cited references are not alleged to teach or suggest a "*tax efficient manner*." The cited references do not individually describe the "*tax efficient manner*" in claim 1, and the combination of the reference would not result in the "*tax efficient manner*" in claim 1. Therefore obviousness has not been established because each and every limitation of claim 1 is not disclosed or suggested by the references, alone or in combination.

Further, n one of the cited references teach or suggest a method comprising, *inter alia*, "*generating a plurality of tables wherein each asset of the one or more identified assets recommended to be sold is included in one of the tables, wherein each table corresponds to a reason that identifies the basis for recommending that assets contained in the table be sold.*" The Examiner alleges that FIG. 9B2 of *Perkel* teaches identifying the bases for recommending that assets be sold. (FOA, Page 6). The Examiner states:

> 14. Perkel teaches that when a client places an order with a broker in response to an advice interaction with a broker, the resulting trade is deemed a "solicited trade" (see paragraph 4). Perkel further teaches that this advice may include recommending to sell for various reasons correlating to an investment strategy for the client's portfolio (see at least FIG. 9B2). Therefore, Perkel teaches identifying the bases for recommending that assets be sold.

Independent claim 1 recites assets in a table that include a reason for recommending why the assets be sold. The "customer advice interaction screen" in FIG 9B2 of *Perkel* has no such feature. First, FIG 9B2 does not show a "*plurality of tables.*" Second, the "customer advice interaction screen" does not include reasons that identify "*the basis for recommending that assets*" be sold. Even if *Perkel* describes a basis for recommending assets be sold, it does not describe displaying those bases in a plurality of tables.

The Examiner further alleges that "displaying a table necessarily entails generating a table." (FOA, Page 12). The Examiner states:

> 43. Examiner acknowledges that Applicants are not claiming "tables" *per se*. However, displaying a table necessarily entails generating a table. Therefore, displaying tables which are grouped by reasons for recommending the sale, as discussed in the rejection of claim 1 above, necessarily entails generating the tables.

Applicant disagrees with this allegation. First, the Applicants challenge the Examiner's assertion that displaying a table necessarily entails generating a table. As stated in MPEP 2112, inherency may not be based on possibilities or probabilities. Here, the tables could be generated by any number of other systems. Thus, displaying a table does not <u>necessarily</u> entail generating a table. Second, independent claim 1 requires, *inter alia*, generating a plurality of tables where "*each asset of the one or more identified assets recommended to be sold is included in one of the tables.*" The "*identified asset*" is based on unique aspects of the other claim limitations of independent claim 1. *Perkel* does not teach such unique aspects. Thus, the process of "*generating*" the table as claimed in the present invention is different than the

purported process described in *Perkel*. Accordingly, the Examiner has not established a prima facie case of obviousness.

Additionally, none of the cited references teach or suggest a method comprising, *inter alia*, "*receiving preferences wherein the preferences also include which of the plurality of accounts are to be included in financial advisory considerations*." The Examiner alleges that paragraphs [0070] and [0071] of *Zeitoun* teaches this feature. (FOA, Page 7). The Examiner states:

> receiving preferences wherein the preferences also include which of the plurality of accounts are to be included in financial advisory considerations (see paragraphs [0070], [0071]);

Independent claim 1 allows for a preference to determine which accounts are to be included in financial advisory considerations. *Zeitoun* does not teach or suggest this feature. *Zeitoun* does not provide the client with the option of selecting "*which of the plurality of accounts are to be included in financial advisory considerations.*" In fact, *Zeitoun* describes that "Every account in the Advisory must be assigned or related to a goal." (See paragraph [0070] of *Zeitoun*). Thus, *Zeitoun* does not describe "*receiving preferences wherein the preferences also include which of the plurality of accounts are to be included in financial advisory considerations,*" because *Zeitoun* describes that every account must be assigned, not just those based on a received preference. The Examiner has not alleged that *Hoffman*, *Bove* or *Perkel* discuss this feature. Accordingly, the Examiner has not established a *prima facie* case of obviousness.

2. Obviousness has not been established, since the references were combined using improper hindsight.

Obviousness has not been established, since the references were combined using improper hindsight. As explained by MPEP 2142:

> To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by

> the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Although not dispositive, the use of four references and Official Notice in rejecting Applicants' claims strongly suggests the use of improper hindsight. For example, *Hoffman* is directed generally to providing investment advice, and does not describe tax advantaged accounts or allocating assets to accounts based on tax efficiencies or in a tax efficient manner. *Bove* describes automatic generation of financial transaction recommendations for modifying a current asset portfolio across multiple accounts. *Bove* merely describes that tax advantaged accounts exist, and that it is possible to buy stocks in tax advantaged accounts, but does not describe allocating assets to the tax advantaged accounts based on tax efficiencies or in a tax efficient manner. The reason that the Examiner uses to combine *Bove* and *Hoffman* is that the combination of features would have had "predictable results being minimizing tax liability." (See page 8 of the FOA). Yet neither *Bove* nor *Hoffman* describe a specific tax efficient manner as it relates to tax advantaged accounts. So it is not clear how the modification of *Hoffman* with *Bove* would have "minimized tax liability" in such a way taught by the present invention. The Applicants' own disclosure describes providing financial advice including placing assets into separate accounts in a particular tax efficient manner which selects assets with least tax efficiency for purchase in the included accounts that are most tax advantaged. The Examiner appears to have used the Applicants' own disclosure as a roadmap for combining the non tax advantaged accounts of *Hoffman* with the underlying methods of modifying asset portfolios of *Bove*. Applicants' submit that this is, without more, is an insufficient rationale to combine, as

the Examiner has impermissibly used the Applicants' own disclosure as a reason for the combination. Thus the obviousness rejection is improper for yet another reason.

Further, viewing *Perkel* and *Hoffman*, without looking at Applicants' disclosure first, would not have led a person of skill in the art to combine *Perkel* and *Hoffman* in the manner proposed by the Examiner. *Perkel* relates generally to providing automated documentation of all advice interactions between brokers and clients. As discussed above, *Perkel's* "customer advice interaction screen" in FIG. 9B2 does not include reasons that identify "the basis for recommending that assets" be sold. Similarly, *Hoffman* does not describe this feature. The Examiner alleges that it would have been obvious to modify the system of *Hoffman* in view of *Perkel* to include identifying the basis for recommending that assts be sold and that such modification would yield "predictable results." (See page 6 of the OA). Yet the Examiner fails to identify what the "predictable results" are. Applicants submit that this is, without more, is an insufficient rationale to combine, and that the obviousness rejection is improper.

B. Hoffman, Perkel, Zeitoun, Bove, and Official Notice

Claims 28 and 33 are rejected as obvious over *Hoffman*, *Perkel*, *Zeitoun*, *Bove*, and Official Notice. This rejection is traversed.

Pursuant to MPEP 2144.03, Applicants challenge the Examiner's taking of Official Notice in each and every instance that this is done in this Office Action and in future Office Actions. In response to Applicant's traversal of the Official Notice taken, the Examiner provided *Kaplan*, ("Asset Allocation Models Using the Markowitz Approach"). As the Examiner has now provided a reference that is alleged to teach the fact for which Official Notice is taken, the need for the Official Notice is obviated. The Examiner has failed to make a *prima facie* case of obviousness with respect to claims 28 and 33 because no rational has been provided as to why a person of skill in the art would have combined *Kaplan* with the previously cited references. Furthermore, claims 28 and 33 are allowable at least by virtue of their dependence

on independent claim 1. Withdrawal of the rejection of claims 28 and 33 is respectfully requested.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,

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